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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,074

12/04/2003

Naomi Sekino

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9168

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EXAMINER

CATTUNGAL, SANJAY

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

04/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,074	<b>Applicant(s)</b> SEKINO ET AL.	
	<b>Examiner</b> SANJAY CATTUNGAL	<b>Art Unit</b> 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12,34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 12/11/2008 have been fully considered but they are not persuasive. Applicant argues that there is no motivation to combine the Ultrasonic vibration device of Kubota with shock wave generating device of Walz. Examiner would like to point out that the invention of Claim 1 merely puts an ultrasonic vibration device and a shockwave generating device in one probe. None of the various elements which the applicant has brought together in his system performs a new function but each operates as it did in the old setting which it is to be found. Combining them, as in the application, established no new functional relationships among them, and the result obtained by the combination, even though an improved one, is not obvious (See: Chicago Pharmacal Co. V. American Home Products, Corp., 126 USPQ 386).
2. Regarding the switching mechanism it would be obvious if you had two energy sources put together in one system, one would need a way to switch between the two sources.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 12/04/2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the foreign references don't have an English translation of the abstract. The specific reference without the English abstract is 61-268244 and has not been considered. It has been placed in the

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application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 4,989,588 to Kubota et al. in view of U. S. Patent No. 5,540,702 to Walz.

6. Regarding claims 1-12, 34, and 35 Kubota teaches an endoscopic lithotripsy apparatus comprising: an elongated probe which includes a distal end and a proximal end, the distal end being to be inserted into a body cavity; an ultrasonic vibration source detachably attached to the proximal end of the probe to transmit an ultrasonic vibration to the probe in a state in which the proximal end of the probe is connected to the

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ultrasonic vibration source (Col. 12 lines 38-44); ultrasonic vibration source includes a Langevin type ultrasonic vibrator to ultrasonically vibrate when a power is supplied to the ultrasonic vibrator, and a horn which is connected to the ultrasonic vibrator to enlarge an amplitude of the ultrasonic vibration generated by the ultrasonic vibrator (Abstract and Claim 2); and the probe and the ultrasonic vibrator are formed on the same axis and have cylindrical shapes in which communication holes communicating with each other are formed, and the ultrasonic vibration source includes a suction device connected to the proximal end of the ultrasonic vibration source so as to be capable of automatically sucking a crushed treatment object through the communication hole in a state in which the ultrasonic vibration is transmitted to the proximal end of the probe from the ultrasonic vibration source (Fig.1 element 27).

7. Kubota does not expressly teach the use of a mechanical shock generator and magnetic coil, for generation and direction of the shock waves.

8. Walz teaches the use of a mechanical shock generator and magnetic coil, for generation and direction of the shock waves. (Abstract, Fig. 1, Claims 1, 3 and 8)

9. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Kubota with a setup for a mechanical shock generator and magnetic coil, for generation and direction of the shock waves as taught by Walz since such a setup would result in a more effective disintegration of calculi, since its used in conjunction with the vibration source. Without the mechanical shock generator breaking the calculi would take a longer time period.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANJAY CATTUNGAL whose telephone number is (571)272-1306. The examiner can normally be reached on 9:30 - 5:00 pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SPC

/Long V Le/  
Supervisory Patent Examiner, Art Unit 3768